

Application No. 10/687,503  
Art Unit: 3721  
Office Action dated: February 24, 2005

### REMARKS

Claims 1, 10 and 22 have been amended to recite the "firing member" as the "firing bar", as per the Examiner's suggestion. Accordingly, no new matter is involved. Claims 1, 10 and 22 have been amended to recite the limitations of claims 2 and/or 11, and claims 2 and 11 have been cancelled herein. Accordingly, no new matter is involved.

In the previous office action, claims 1-22 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated:

"Claims 1, 10 and 22 recite the phrase "said firing bar" in lines 7, 8 and 11 of claim 1, lines 8-10 and 13 in claim 10, and lines 7.8.11.13 and 14 of claim 22. There is insufficient antecedent basis for these limitations in the claims. The remainder of the claims, excluding claims 8, 16 and 21, also recite the phrase "said firing bar", which is improper. Perhaps changing the phrase "a firing member" in line 5 of claim 1, line 6 of claim 10, and line 5 of claims 22 to read "a firing bar" would correct the problem."

As noted above Claims 1, 10 and 22 have been amended to recite the "firing member" as the "firing bar", as per the Examiner's suggestion. Therefore, it is respectfully requested that the Examiner withdraw the 35 U.S.C. 112 rejections to Applicants claims.

In the previous office action, the Examiner rejected Claims 1, 9, 10, 14, 20 and 22 under 35 U.S.C. 103(a) as being unpatentable over Milliman et al. (USPN 6,669,073) in view of Geiste et al. (USPN 6,202,914). However, the Examiner also indicated that claims 2-8, 11-13, 15-19 and 21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in the Office action and to include all of the limitations of the base claim and any intervening claims.

As noted above claims 1, 10 and 22 have been amended to recite the limitations of claims 2 and/or 11, and claims 2 and 11 have been cancelled herein. Therefore, Applicants submit that all pending claims are now fully allowable over the prior art cited by the

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Examiner. Therefore, Applicants respectfully request that the Examiner re-examine and favorably reconsider Applicants' claims in the form of a Notice of Allowance.

Respectfully submitted,

By: Dean L. Garner/  
Dean L. Garner, Esq.  
Reg. No. 35,877  
Attorney for Applicant(s)

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
(513) 337-8559  
Date: April 18, 2005



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,503	10/15/2003	Kevin Doll	END-887CIP	9046
2777	7390	02/24/2005	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			WEEKS, GLORIA R	
			ART UNIT	PAPER NUMBER
			3721	

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FEB 28 2005

J&amp;J PAT. DKT. SECTION

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<b>Office Action Summary</b>	Application No.		Applicant(s)	
	10/687,503		DOLL ET AL.	
	Examiner		Art Unit	
	Gloria R Weeks		3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 29 July 2004.

2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-22 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date _____ 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____
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U.S. Patent and Trademark Office  
PTOL-326 (Rev. 1-04)

Office Action Summary

Part of Paper No./Mail Date 02032005

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*Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 10 and 22 recite the phrase "said firing bar" in lines 7, 8 and 11 of claim 1, lines 8-10 and 13 in claim 10, and lines 7, 8, 11, 13 and 14 of claim 22. There is insufficient antecedent basis for these limitations in the claims. The remainder of the claims, excluding claims 8, 16 and 21, also recite the phrase "said firing bar", which is improper. Perhaps changing the phrase "a firing member" in line 5 of claim 1, line 6 of claim 10, and line 5 of claims 22 to read "a firing bar" would correct the problem.

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 9, 10, 14, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milliman et al. (USPN 6,669,073) in view of Geiste et al. (USPN 6,202,914). ✓✓

In reference to claims 1, 9, 10, 14, 20 and 22 Milliman et al. discloses a surgical stapling instrument comprising: a cartridge (220) containing a wedge member (234), the wedge member

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(234) moveable longitudinally within the cartridge (220) to eject said staples from the cartridge (220); an elongate channel (216); a firing member (212) having a sharp edge (280), a support member (285) interacting with the elongate channel (216; figure 45), and cooperatively engagable with the wedge member (234; column 13 lines 5-8)) and longitudinally moveable in a distal direction; and a locking mechanism (288). The locking mechanism of Millimane et al prevents distal movement of the firing member (212), although it is not biased by the wedge member (234).

Geiste et al. discloses a surgical stapling instrument comprising: a cartridge (22) containing a wedge member (134); an elongate channel (114) having a reception feature (figures 13 & 13A); a firing member (144) including a sharp edge for cutting; a locking mechanism (120) for preventing distal movement of the firing bar (144) after the firing member (144) has been moved proximally a predetermined distance, wherein the wedge member (134) biases the firing member (144) into an unlocked (column 7 lines 10-18) and wherein the (134) wedge. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the firing member of Milliman et al. to include the locking mechanism of Geiste et al. for the purpose of preventing reactuation of the instrument after it has been actuated.

*Allowable Subject Matter*

5. Claims 2-8, 11-13, 15-19 and 21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to attachment for notice of references cited and recommended for consideration based on their disclosure of limitations of the claimed invention.

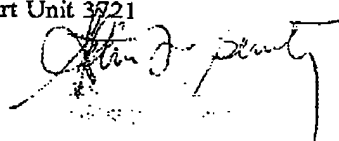
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria R Weeks whose telephone number is (571) 272-4473. The examiner can normally be reached on 7:30 am - 6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
February 14, 2005

Gloria R Weeks  
Examiner  
Art Unit 3721



<b>Notice of References Cited</b>	Application/Control No. 10/687,503	Applicant(s)/Patent Under Reexamination DOLL ET AL	
	Examiner Gloria R Weeks	Art Unit 3721	Page 1 of 1

U.S. PATENT DOCUMENTS					
*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,669,073	12-2003	Milliman et al.	227/175.2
*	B	US-6,202,914	03-2001	Geiste et al.	227/176.1
*	C	US-6,032,849	03-2000	Mastri et al.	227/176.1
*	D	US-5,487,500	01-1998	Knodel et al.	227/181.1
*	E	US-5,871,135	02-1999	Williamson IV et al.	227/178.1
*	F	US-5,826,778	10-1998	Schulze et al.	227/178.1
*	G	US-5,762,255	06-1998	Chrisman et al.	227/175.2
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS						
*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS		
*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See page 1, item 1.)

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

U.S. Patent and Trademark Office  
PTO-892 (Rev. 01-2001)

Notice of References Cited

Part of Paper No. 02032005